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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO
08/250,770	05/27/94	KIM Y	P53706

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EXAMINER	
YOCKEY, D	
ART UNIT	PAPER NUMBER
2108	

DATE MAILED: 01/07/97

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Advisory Action

Application No.	Applicant(s)
08/250,770	Kim
Examiner	**Group Art Unit**
David Yockey	2108

THE PERIOD FOR RESPONSE: [check only a) or b)]

a) ☐ expires _____ months from the mailing date of the final rejection.

b) ☐ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

☒ Appellant's Brief is due two months from the date of the Notice of Appeal filed on *Dec 10, 1996* (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on *Dec 10, 1996* has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

☒ The proposed amendment(s):

☒ will be entered upon filing of a Notice of Appeal and an Appeal Brief.

☐ will not be entered because:

☐ they raise new issues that would require further consideration and/or search. (See note below).

☐ they raise the issue of new matter. (See note below).

☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: _____

☒ Applicant's response has overcome the following rejection(s):
The rejection under 35 USC 112, first paragraph.

☐ Newly proposed or amended claims _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.

☒ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:
the claims remain unpatentable for the reasons presented in the final Office Action and in the sheets attached hereto.

☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: _____

Claims objected to: _____

Claims rejected: *1-24*

☐ The proposed drawing correction filed on _____ ☐ has ☐ has not been approved by the Examiner.

☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). _____.

☐ Other

BENJAMIN R. FULLER
SUPERVISORY PATENT EXAMINER
ART UNIT 218

Response to Amendment

1. The objection to the specification concerning the "Cross Reference To Related Applications" section and the objection and rejection under 35 USC 112, first paragraph are hereby withdrawn in view of Applicants' amendment filed 12-10-96.

Response to Arguments

2. Applicant's arguments filed 12-10-96 have been fully considered but they are not persuasive.

Applicant's request that the Examiner suggest a legend that does not indicate that Figs. 2A-2D are prior art and request that the Examiner withdraw the objection to the specification regarding page 7, line 12 through page 10, line 8 of the specification are denied because the figures illustrate prior art as noted previously during the prosecution.

Applicant's argument regarding admissions pertaining to various means is noted. Contrary to Applicants' position, the admissions indicate that there is no difference between the disclosed and claimed print control means and the prior art print control means; however, these admissions are not taken as admissions that particular connections of other elements to the print control means other than those indicated in Fig. 1 are included in the prior art.

Applicant argues that the rejection of claims 1-4 and 6-22 under 35 USC 112, second paragraph is in error. The Examiner agrees; the leading paragraph in the rejection under 35 USC 112, second paragraph should read "Claims 5 and 23..." rather than "Claims 1-24...".

Applicant argues that the "enabling..." recited in claim 5 constitutes a function specified for the recited means. This argument is not deemed to be persuasive. The claim does not recite "means for enabling..." as would conform to 35 USC 112, sixth paragraph, but instead recited "means enabling...". Comparison of the claimed recitation to the format conforming to 35 USC 112, sixth paragraph provides proof that the claimed recitation does not conform to the format of a "means" recitation set forth in 35 USC 112, sixth paragraph.

Applicant's argument with regard the rejection of claim 23 under 35 USC 112, second paragraph is deemed to be persuasive and this ground of rejection is hereby withdrawn.

At page 8, line 15 through page 9, line 4, Applicant argues that the fact that Tomita and Hayashi et al. are silent with regard to changing the bias voltage of a developer to adjust the amount of the toner developed is germane to the issue because this limitation is not found in the claims and is found in Prior Art Fig. 1. This argument is not deemed to be persuasive. The claims do not include changing the bias voltage of a developer to adjust the amount of the toner developed and thus the prior art need not include such a limitation. Further, the fact that the combination of references may include changing the bias voltage of a developer to adjust the amount of the toner developed is not germane to the issue since the claims recite that the invention as "comprising" the elements thereof.

Applicant argues that there is no factual evidence that there is a problem with Prior Art Fig. 1 with regard to forming an image with satisfactory tonal rendition due to changes in

environmental conditions. This argument is not deemed to be persuasive. As disclosed, the bias voltage in the Prior Art Fig. 1 apparatus is changed *manually* and is nowhere disclosed as being changed in response to environmental conditions (see page 3, line 14 through page 4, line 2). Further, the prior art as a whole suggests that changes in environmental conditions would effect tonal rendition in an apparatus without compensation for such changes. Thus, there is ample suggestion that the Prior Art Fig. 1 apparatus includes the problem solved by the combination.

Applicants argue that there is no reason to include the teaching of Tomita in the combination. This argument is not deemed to be persuasive. Both the Tomita and Hayashi et al. apparatus change power of a light source, where Tomita changes the power level by chopping pulses and Hayashi et al. changes power level by changing applied current. Thus, the two power sources are clearly equivalent for changing a power level of a light beam in a recording apparatus and would be obviously interchangeable so as to obtain well known advantages of one over the other; e.g. pulse width modulation techniques such as chopping pulses to change power level do not cause difficulty obtaining linear reproduction and intensity modulation techniques such as changing applied current forms images of constant resolution.

Applicant's remaining arguments are deemed to be fully addressed by the remarks above and the rejection and remarks presented in the final Office Action.

3. Any inquiry concerning this communication should be directed to David Yockey at telephone number (703) 308-3084.

dy
January 5, 1997